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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,071	01/04/2002	Craig Storms	30566.203-US-01	7330
55895 7590 02/04/2008 GATES & COOPER LLP HOWARD HUGHES CENTER 6701 CENTER DRIVE WEST, SUITE 1050 LOS ANGELES, CA 90045			EXAMINER BETIT, JACOB F	
			ART UNIT 2164 /	PAPER NUMBER
			MAIL DATE 02/04/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/038,071

Applicant(s)

STORMS ET AL.

Examiner

Jacob F. Bétit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) 1-11, 25-37, 51-63 and 77-89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 12-24, 38-50 and 64-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Remarks*

1. In view of the Appeal Brief filed on 19 July 2007, PROSECUTION IS HEREBY REOPENED. *A new ground of rejection is set forth below.*

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. The indicated allowability of claims 13, 39, and 65 is withdrawn in view of the newly discovered reference to Kark et al. (U.S. patent application publication No. 2002/0107761 A1). Rejections based on the newly cited reference follow.

### *Election/Restrictions*

3. Claims 1-11, 25-37, 51-63, and 77-89 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 13 January 2005. The applicants arguments with regards to the restriction were responded to and the restriction was made FINAL in the Office Action dated 21 April 2005.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 12-16, 18-24, 38-42, 44-50, 64-68, and 70-76 rejected under 35 U.S.C. 102(e) as being anticipated by Kark et al. (U.S. patent application publication No. 2002/0107761 A1).

As to claim 12, Kark et al. teaches a method for generating product data in a self-expanding data package in a computer system comprising:

generating one or more values in a set of one or more constant lists and storing said one or more values in the self-expanding data package, wherein the self-expanding data package is for product data (see paragraphs 0085 and 0092-0095);

generating one or more calculations that operate on one or more values in the set of one or more constant lists and storing said one or more calculations in the self-expanding data package (see paragraphs 0052, 0055, 0092-0095, and 0098);

transmitting the self-expanding data package to a second computer system that expands the self-expanding data package into an expanded table having expanded table rows, wherein each expanded table row represents a product and comprises a combination and each combination is generated by combining every value in each constant list with any combination of values from remaining parameters and performing the one or more calculations on the one or more values, wherein the one or more calculations eliminate one or ore expanded table rows (see paragraphs 038, 0052, 0055, 0092-0095, 0098, and 105).

As to claims 13, 39, and 65, Kark et al. teaches further comprising, generating one or more basic table data having one or more table rows, and storing said one or more basic table data in the self expanding data package wherein the self-expanding data package is further expanded by combining every value in each constant list with each basic table row (see paragraph 0085 and 0092-0095).

As to claims 14, 40, and 66, Kark et al. teaches wherein one or more calculations are applied to test validity of the expanded table rows, and only those expanded table rows that are valid are maintained in the expanded table (see paragraphs 0052 and 0098).

As to claims 15, 41, and 67, Kark et al. teaches wherein one or more calculations are utilized to perform a precursor conditional test that is used to test validity of the expanded table rows (see paragraphs 0052 and 0098).

As to claims 16, 42, 68, Kark et al. teaches wherein one or more calculations are utilized to provide additional data used in the expanded table (see paragraphs 0092-0095).

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As to claims 18, 44, and 70, Kark et al. teaches wherein one or more calculations provide for eliminating duplicate expanded table rows (see paragraph 0107).

As to claims 19, 45, 71, Kark et al. teaches wherein the self-expanding data package is written in extensible markup language (XML) (see paragraph 0038).

As to claims 20, 46, and 72, Kark et al. teaches wherein one or more calculations are selected through a graphical user interface (see paragraph 0102).

As to claims 21, 47, and 73, Kark et al. teaches wherein the self-expanding data package is transmitted across a network (see paragraph 038).

As to claims 22, 48, 74, Kark et al. teaches wherein one or more calculations comprise one or more filters that limit results displayed from the expanded table rows (see paragraph 0098).

As to claim 23, 49, and 75, Kark et al. teaches wherein an editor is used to directly edit the self-expanding data package (see paragraph 0102).

As to claim 24, 50, and 76, Kark et al. teaches wherein logic for expanding the data package into the expanded table is fully defined within the data package and the data (see paragraph 0052, 0055, 0092-0095 and 0098).

As to claim 38, Kark et al. teaches an apparatus for generating product data in a self-expanding data package in a computer system comprising:

(a) a computer system having a memory and a data storage device coupled thereto; (b) one or more computer programs, performed by the computer system, for generating a self-expanding data package and storing the self-expanding data package in the memory (see paragraphs 0004-0006), wherein the self-expanding data package is for product data and comprises:

(i) one or more values in a set of one or more constant lists (see paragraphs 038, 0052, 0055, 0092-0095, 0098, and 105); and

(ii) one or more calculations that operate on one or more values in the set of one or more constant lists (see paragraphs 0052, 0055, 0092-0095, and 0098);

wherein the self-expanding data package is transmitted to a second computer system that expands the self-expanding data package into an expanded table having expanded table rows, wherein each expanded table row represents a product and comprises a combination and each combination is generated by combining every value in each constant list with any combination of

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values from remaining parameters and performing the one or more calculations on the one or more values, wherein the one or more calculations eliminate one or more expanded table rows (see paragraphs 038, 0052, 0055, 0092-0095, 0098, and 105).

As to claim 64, Kark et al. teaches an article of manufacture comprising a program storage medium readable by a computer and embodying one or more instructions executable by the computer to perform a method for generating product data in a self-expanding data package in a computer system, the method comprising:

generating, in the self-expanding data package, one or more values in a set of one or more constant lists, wherein the self-expanding data package is for product data(see paragraphs 0085 and 0092-0095);

generating, in the self-expanding data package, one or more calculations that operate on one or more values in the set of one or more constant lists(see paragraphs 0052, 0055, 0092-0095, and 0098);

wherein the self-expanding data package is transmitted to a second computer system that expands the self-expanding data package into an expanded table having expanded table rows, wherein each expanded table row represents a product and comprises a combination and each combination is generated by combining every value in each constant list with any combination of values from remaining parameters and performing the one or mote calculations on the one or more values, wherein the one or more calculations eliminate one more expanded table rows (see paragraphs 038, 0052, 0055, 0092-0095, 0098, and 105).



***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17, 43, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kark et al.

As to claims 17, 43, and 69, Kark et al. teaches wherein the self-expanding data package comprises product data (see abstract).

However, Kark et al. does not distinctly disclose product data *for use* in a computer-aided design application. Since this is only the intended use of the product data however, it fails to further limit the claim. See MPEP 2106 II C. where it is stated:

Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of the claim or the claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or filed of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This is not intended to be exhaustive.

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Further it is noted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the product data found in Kark et al. in a CAD application while updating the products found in the data package. This would allow the designer to update the package with new features, specifications, and attributes as the updated product is being produced.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Imamura et al. (U.S. patent No. 6,128,600) for teaching defining electronic catalogue data.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob F. Bétit whose telephone number is (571) 272-4075. The examiner can normally be reached on Monday through Friday 9:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



CHARLES RONES  
SUPERVISORY PATENT EXAMINER

jfb  
25 Jan 2008